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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,562	10/14/2003	Dale W. Malik	190250-1440	4930

38823 7590 01/03/2007
THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP/
BELLSOUTH I.P. CORP
100 GALLERIA PARKWAY
SUITE 1750
ATLANTA, GA 30339

EXAMINER	
DAILEY, THOMAS J	
ART UNIT	PAPER NUMBER
2196	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	**Application No.** 10/685,562	**Applicant(s)** MALIK, DALE W.	
	Examiner Thomas J. Dailey	**Art Unit** 2196	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _14 October 2003_.
2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-24_ is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _1-24_ is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a)☐ All b)☐ Some * c)☐ None of:
1.☐ Certified copies of the priority documents have been received.
2.☐ Certified copies of the priority documents have been received in Application No. _____.
3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _10/14/2003_.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-24 are pending in this application.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure:

3. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

   The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The applicant's abstract is less than 50 words.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

   > Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 10-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

7. As to claims 10 and 12, a "system" is being recited; however, as the system comprises only "logic configured to," the systems of claims 10 and 12 can be reasonably interpreted as functionally descriptive material.

8. As to claims 11 and 13-24, as provided on page 48 of the specification, a computer readable medium includes propagation media, including electrical connections and fiber optics. Claims drawn to components involving signals encoded with functional descriptive material do not fall within any of the categories of statutory subject matter as set forth in 35 U.S.C. 101, and are therefore, ineligible for protection.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 5, 9, 10-13, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by DeSimone et al. (US Pat. No. 6,212,548 B1), hereafter "DeSimone."

11. As to claim 1, DeSimone discloses a communication method (Abstract) comprising the steps of:

establishing an instant messaging (IM) chat session between a first sender and a recipient (column 6, lines 40-56, "Dawn" reading on "the first sender" and "Mike" reading on "a recipient");

receiving an IM message from a second sender to the recipient (column 9, lines 55-64 and Fig. 5B, "Dave" reading on "a second sender"); and

establishing an IM chat room between the recipient, the first sender, and the second sender (column 7, lines 54-59 and column 8, lines 54-58).

12. As to claim 5, DeSimone discloses a communication method (Abstract) comprising the steps of:

receiving an instant messaging (IM) message from a latter sender to a recipient (column 9, lines 55-64 and Fig. 5B, "Dave" reading on "a latter sender" and "Mike" reading on a "recipient");

determining whether an IM chat session is established between the recipient and an earlier sender (column 7, lines 54-59, column 8, lines 54-58, "Dawn" reading on "an earlier sender", and the determination step occurring in the pseudo code in column 9, specifically the if-loop with (ChatRoomName+Creator-Id does not exist) label at line 7); and

establishing an IM chat room between the recipient, the earlier sender, and the latter sender in response to determining that an IM chat session is established between the recipient and the earlier sender (column 7, lines 54-59 and column 8, lines 54-58).

13. As to claim 9, DeSimone discloses a communication system (Abstract) comprising:

means for establishing an instant messaging (IM) chat session between a first sender and a recipient (column 6, lines 40-56, "Dawn" reading on "the first sender" and "Mike" reading on "a recipient");

means for receiving an IM message from a second sender to the recipient (column 9, lines 55-64 and Fig. 5B, "Dave" reading on "a second sender"); and

means for establishing an IM chat room between the recipient, the first sender, and the second sender (column 7, lines 54-59 and column 8, lines 54-58).

14. As to claim 10, DeSimone discloses a communication system (Abstract) comprising:

logic configured to establish an instant messaging (IM) chat session between a first sender and a recipient (column 6, lines 40-56, "Dawn" reading on "the first sender" and "Mike" reading on "a recipient");

logic configured receive an IM message from a second sender to the recipient (column 9, lines 55-64 and Fig. 5B, "Dave" reading on "a second sender"); and logic configured establishing an IM chat room between the recipient, the first sender, and the second sender (column 7, lines 54-59 and column 8, lines 54-58).

15. As to claim 11, DeSimone discloses a communication system comprising (Abstract):

means for receiving an instant messaging (IM) message from a latter sender to a recipient (column 9, lines 55-64 and Fig. 5B, "Dave" reading on "a latter sender" and "Mike" reading on a "recipient");

means for determining whether an IM chat session is established between the recipient and an earlier sender (column 7, lines 54-59, column 8, lines 54-58, "Dawn" reading on "an earlier sender", and the determination step occurring in the pseudo code in column 9, specifically the if-loop with (ChatRoomName+Creator-Id does not exist) label at line 7); and

means for establishing an IM chat room between the recipient, the earlier sender, and the latter sender in response to determining that an IM chat session is established between the recipient and the earlier sender (column 7, lines 54-59 and column 8, lines 54-58).

16. As to claim 12, DeSimone discloses a communication system (Abstract) comprising the steps of:

logic configured to establish receive an instant messaging (IM) message from a latter sender to a recipient (column 9, lines 55-64 and Fig. 5B, “Dave” reading on “a latter sender” and “Mike” reading on a “recipient”);

logic configured to determine whether an IM chat session is established between the recipient and an earlier sender (column 7, lines 54-59, column 8, lines 54-58, “Dawn” reading on “an earlier sender”, and the determination step occurring in the pseudo code in column 9, specifically the if-loop with (ChatRoomName+Creator-Id does not exist) label at line 7); and

logic configured to establish an IM chat room between the recipient, the earlier sender, and the latter sender in response to determining that an IM chat session is established between the recipient and the earlier sender (column 7, lines 54-59 and column 8, lines 54-58).

17. As to claim 13, DeSimone discloses a computer-readable medium (Abstract, both the clients and servers will inherently contain a computer-readable media, as they are computers) comprising:

computer-readable code adapted to instruct a programmable device (the method and system of DeSimone is clearly code as shown by the extensive use of pseudo code, such as columns 7 and 9) to establish an instant messaging (IM) chat session between a first sender and a recipient (column 6, lines 40-56, "Dawn" reading on "the first sender" and "Mike" reading on "a recipient");

computer-readable code adapted to instruct a programmable device to receive an IM message from a second sender to the recipient receive an IM message from a second sender to the recipient (column 9, lines 55-64 and Fig. 5B, "Dave" reading on "a second sender"); and

computer-readable code adapted to instruct a programmable device to establish an IM chat room between the recipient, the first sender, and the second sender(column 7, lines 54-59 and column 8, lines 54-58).

18. As to claim 19, DeSimone discloses a computer-readable medium (Abstract, both the clients and servers will inherently contain a computer-readable media, as they are computers) comprising:

computer-readable code adapted to instruct a programmable device (the method and system of DeSimone is clearly code as shown by the extensive use of pseudo code, such as columns 7 and 9) to receive an instant messaging (IM) message from a latter sender to a recipient (column 9, lines 55-64 and Fig. 5B, "Dave" reading on "a latter sender" and "Mike" reading on a "recipient");

computer-readable code adapted to instruct a programmable device to determine whether an IM chat session is established between the recipient and an earlier sender (column 7, lines 54-59, column 8, lines 54-58, "Dawn" reading on "an earlier sender", and the determination step occurring in the pseudo code in column 9, specifically the if-loop with (ChatRoomName+Creator-Id does not exist) label at line 7); and

computer-readable code adapted to instruct a programmable device to establish an IM chat room between the recipient, the earlier sender, and the latter sender in response to determining that an IM chat session is established between the recipient and the earlier sender (column 7, lines 54-59 and column 8, lines 54-58).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

20. Claims 2, 6, 14, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone, as applied to claims 1, 5, 13, and 19, respectively, in view of Morris et al. (US Pat. No. 6,496,851 B1), hereafter "Morris."

21. As to claims 2 and 14, DeSimone does not explicitly disclose:

issuing an invitation to join the IM chat session, the invitation being issued to the second sender;

receiving a reply from the second sender, the reply being one selected from the group consisting of:

an acceptance of the invitation to join the IM chat session; and

a rejection of the invitation to join the IM chat session; and

wherein the step of establishing the IM chat room is responsive to the reply being the acceptance of the invitation to join the IM chat session.

Morris discloses:

issuing an invitation to join the IM chat session, the invitation being issued to the second sender (column 12, lines 5-13);

receiving a reply from the second sender (Fig. 13 and column 12, lines 26-43), the reply being one selected from the group consisting of:

an acceptance of the invitation to join the IM chat session (column 12, lines 19-25); and

a rejection of the invitation to join the IM chat session (Fig. 13, lines 37-43); and

wherein the step of establishing the IM chat room is responsive to the reply being the acceptance of the invitation to join the IM chat session (column 12, lines 13-25).

Therefore it would have been obvious at the time of the invention to combine the teachings of DeSimone and Morris in order to allow user to negotiate with others through the use of invitations and proposals which increases the options available to each user (DeSimone, column 3, lines 36-43).

22. As to claims 6 and 20, DeSimone does not explicitly disclose:

issuing an invitation to join the IM chat session, the invitation being issued to the latter sender;

receiving a reply from the latter sender, the reply being one selected from the group consisting of:

an acceptance of the invitation to join the IM chat session; and a rejection of the invitation to join the IM chat session; and

establishing the IM chat room in response to the reply being the acceptance of the invitation to join the IM chat session.

Morris discloses:

issuing an invitation to join the IM chat session, the invitation being issued to the latter sender (column 12, lines 5-13);

receiving a reply from the latter sender (Fig. 13 and column 12, lines 26-43), the reply being one selected from the group consisting of:

23. an acceptance of the invitation to join the IM chat session (column 12, lines 19-25); and

a rejection of the invitation to join the IM chat session (Fig. 13, lines 37-43); and wherein the step of establishing the IM chat room is responsive to the reply being the acceptance of the invitation to join the IM chat session (column 12, lines 13-25).

Therefore it would have been obvious at the time of the invention to combine the teachings of DeSimone and Morris in order to allow user to negotiate with others through the use of invitations and proposals which increases the options available to each user (DeSimone, column 3, lines 36-43).

24. Claims 3, 4, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone, as applied to claims 1 and 5, respectively, in view of Walker et al. (US Pub. No. 2003/0064807 A1), hereafter "Walker."

25. As to claims 3 and 7, DeSimone does not explicitly disclose:

issuing a request for permission to join the IM chat session, the request for permission being issued to the recipient;

receiving a reply from the recipient, the reply being one selected from the group consisting of: granting permission to join the IM chat session; and

denying permission to join the IM chat session; and

wherein the step of establishing the IM chat room is responsive to the reply being the granting of permission to join the IM chat session.

Walker discloses:

issuing a request for permission to join the IM chat session, the request for permission being issued to the recipient ([0132], lines 1-5, the "groups" in particular embodiments include chat sessions as shown in [0242]);

receiving a reply from the recipient ([0132], lines 5-12), the reply being one selected from the group consisting of:

granting permission to join the IM chat session ([0132], lines 5-12); and

denying permission to join the IM chat session ([0132], lines 5-12); and wherein the step of establishing the IM chat room is responsive to the reply being the granting of permission to join the IM chat session ([0132], lines 5-12).

Therefore it would have been obvious at the time of the invention to combine the teachings of DeSimone and Walker in order to allow to provide security and prevent undesired access to created chat rooms.

26. As to claims 4 and 8, DeSimone does not explicitly disclose:

issuing a request for permission to join the IM chat session, the request for permission being issued to the first sender;

receiving a reply from the first sender, the reply being one selected from the group consisting of:

granting permission to join the IM chat session; and

denying permission to join the IM chat session; and wherein the step of establishing the IM chat room is responsive to the reply being the granting of permission to join the IM chat session.

Walker discloses:

issuing a request for permission to join the IM chat session, the request for permission being issued to the first sender ([0132], lines 1-5, the "groups" in particular embodiments include chat sessions as shown in [0242]);

receiving a reply from the first sender ([0132], lines 5-12), the reply being one selected from the group consisting of:

granting permission to join the IM chat session ([0132], lines 5-12); and

denying permission to join the IM chat session ([0132], lines 5-12); and

wherein the step of establishing the IM chat room is responsive to the reply being the granting of permission to join the IM chat session ([0132], lines 5-12).

Therefore it would have been obvious at the time of the invention to combine the teachings of DeSimone and Walker in order to allow to provide security and prevent undesired access to created chat rooms.

27. Claims 15-18 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone in view of Morris, as applied to claims 14 and 20, respectively, in further view of Walker.

28. As to claims 15 and 21, DeSimone and Morris do not disclose:

computer-readable code adapted to instruct a programmable device to issue a request for permission to join the IM chat session, the request for permission being issued to the recipient; and

computer-readable code adapted to instruct a programmable device to receive a reply from the recipient, the reply from the recipient being one selected from the group consisting of:

granting permission to join the IM chat session; and

denying permission to join the IM chat session.

Walker discloses:

computer-readable code adapted to instruct a programmable device to issue a request for permission to join the IM chat session, the request for permission being issued to the recipient ([0132], lines 1-5, the "groups" in particular embodiments include chat sessions as shown in [0242]);

computer-readable code adapted to instruct a programmable device to receive a reply from the recipient ([0132], lines 5-12), the reply being one selected from the group consisting of:

granting permission to join the IM chat session ([0132], lines 5-12); and

denying permission to join the IM chat session ([0132], lines 5-12).

Therefore it would have been obvious at the time of the invention to combine the teachings of DeSimone and Morris with the teaching of Walker in order to allow to provide security and prevent undesired access to created chat rooms.

29. As to claims 16 and 22, DeSimone and Morris do not disclose:

computer-readable code adapted to instruct a programmable device to issue a request for permission to join the IM chat session, the request for permission being issued to the first sender; and

computer-readable code adapted to instruct a programmable device to receive a reply from the first sender, the reply from the recipient being one selected from the group consisting of:

granting permission to join the IM chat session; and

denying permission to join the IM chat session.

Walker discloses:

computer-readable code adapted to instruct a programmable device to issue a request for permission to join the IM chat session, the request for permission being issued to the first sender ([0132], lines 1-5, the "groups" in particular embodiments include chat sessions as shown in [0242]);

computer-readable code adapted to instruct a programmable device to receive a reply from the first sender ([0132], lines 5-12), the reply being one selected from the group consisting of:

granting permission to join the IM chat session ([0132], lines 5-12); and

denying permission to join the IM chat session ([0132], lines 5-12).

Therefore it would have been obvious at the time of the invention to combine the teachings of DeSimone and Morris with the teaching of Walker in order to allow to provide security and prevent undesired access to created chat rooms.

30. As to claims 17 and 23, Morris discloses:

computer-readable code adapted to instruct a programmable device to establish the IM chat room in response to (column 12, lines 13-25):

the reply from the second sender being the acceptance of the invitation to join the IM chat session (column 12, lines 13-25);

31. DeSimone and Morris do not disclose:

computer-readable code adapted to instruct a programmable device to establish the IM chat room in response to:

the reply from the recipient being the granting of permission to join the IM chat session; and

the reply from the first sender being the granting of permission to join the IM chat session.

Walker discloses:

computer-readable code adapted to instruct a programmable device to establish the IM chat room ([0132], lines 1-5, the “groups” in particular embodiments include chat sessions as shown in [0242]) in response to:

the reply from the recipient being the granting of permission to join the IM chat session ([0132], lines 5-12); and the reply from the first sender being the granting of permission to join the IM chat session ([0132], lines 5-12).

Therefore it would have been obvious at the time of the invention to combine the teachings of DeSimone and Morris with the teaching of Walker in order to allow to provide security and prevent undesired access to created chat rooms.

32. As to claim 18 and 24, Morris discloses computer-readable code adapted to instruct a programmable device to establish the IM chat room in response to at least one of (column 12, lines 13-25):

the reply from the second sender being the acceptance of the invitation to join the IM chat session (column 12, lines 13-25);

the reply from the recipient being the granting of permission to join the IM chat session; and

the reply from the first sender being the granting of permission to join the IM chat session.

Conclusion

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Dailey whose telephone number is 571-270-1246. The examiner can normally be reached on Monday thru Friday; 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nabil El-Hady can be reached on 571-272-3963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TJD
12/20/2006

N. ElHady

NABIL M. EL-HADY
SUPERVISORY PATENT EXAMINER